

Remarks

Claims 23, 24 and 26-41 are pending in the application. In the Office Action Summary, claims 23, 24 and 26-41 stand rejected. In the Detailed Action, claims 23 and 26-41 were rejected under 35 U.S.C. § 101 as non-patentable subject matter, and claims 23 and 26-41 were rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement. Therefore, the Examiner has failed to indicate the grounds of rejection for claim 24, and consequently, Applicants treat claim 24 as containing allowable subject matter and have therefore rewritten claim 24 into independent form.¹ Applicants respectfully request allowance of claim 24, as well as the other pending claims for at least the reasons set forth below.

Rejections Under 35 U.S.C. § 101

Claims 23 and 26-40 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner asserts that the limitations could be met without the use of technology and that none of the rejected claims use a computer. However, as the Examiner admits, “[t]he preamble states that the method is computer-implemented . . .” (Office Action, page 2.) The Examiner opines that although the words “computer-implemented” are recited in the preamble, only claims 24 and 41 actually use a computer. Applicants respectfully traverse the Examiner’s grounds for rejection.

Independent claim 23 contains the limitation of “receiving data.” To persons having ordinary skill in the art of utilizing computer-implemented methods for estimating market value, data is defined as “numerical or other information represented in a form suitable for processing by computer.” *See*, THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed., 2000). *See also*, Denis Howe, THE FREE ON-LINE DICTIONARY OF COMPUTING (1993)(defining data as “[n]umbers, characters, images, or other method of

¹ Applicants note that since the Detailed Action did not address all pending claims, if there is a further Office Action issued by the Examiner, it should be considered non-final.

recording in a form which can be assessed by a human or (especially) input into a computer") (emphasis added) *at* <http://foldoc.doc.ic.ac.uk/foldoc/foldoc.cgi?query=data>, *last visited* Feb 21, 2005.

Therefore, the Examiner's assertion that the rejected claims are non patentable under § 101 has been obviated, and Applicants respectfully request the rejection to be withdrawn.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 23 and 26-41 were rejected under 35 U.S.C. § 112, first paragraph as containing subject matter not described in the specification in such a way as to enable one skilled in the art to make or use the invention. However, while the Examiner focuses solely on the language of the claims as the sole basis for lack of enablement, the proper inquiry looks to the entire disclosure of an application to determine whether it informs those skilled in the art on how to make and use the invention. *See*, MPEP § 2164. The Examiner asserts that the terms "constraint for determining a neighbor relationship," "neighborhood distance function," "determining a distance between a pair of used," and "determining an estimate value based on the data from the nearest neighbor data base" are not enabled in this specification.

Examples of typical neighbor constraints as provided in the specification are "model, series, and model year." (Application, pg 6, lines 17-18.) Neighborhood distance functions are described as "formulas which map or correlate a difference in features or vehicle contents between the pair of vehicles to an amount of used vehicle resale value." (Application, page 8, lines 23-26.) An example of how to use the function to determine distance between a pair of used vehicles is also provided. (Application, page 8, line 26 to page 9, line12.) Finally, a step of determining an estimate value based on the data would be understood by those skilled in the art as demonstrated in Figure 2 and discussed in the application. (Application, page 9, line 13 to page 11, line 4.)

Regarding claim 33, the Examiner argues that "from the claims, it would not be possible for one of ordinary skill in the art to know if they were infringing on the claimed invention." However, as previously discussed, when considering enablement, the Examiner must look at the claims in light of the specification. Regarding the variables discussed in claim 33, discussion of their meaning and interrelation is found in discussions of Figures 3 and 4, beginning on page 11, line 5 and continuing through to page 13, line 20. Applicants assert that the specification contains sufficient information regarding the subject matter of the claims as to enable one skilled in the art to make and use the invention without undue experimentation.

CONCLUSION

For the foregoing reasons, Applicants believe that the Office Action of January 26, 2005 has been fully responded to. Consequently, in view of the above amendments and remarks, Applicants respectfully submit that the application is in condition for allowance, which allowance is respectfully requested.

Respectfully submitted,

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